

Application No. 10/810,081

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REMARKS

Claims 1 and 49 are currently amended. Claims 2-7, 50-54 and 66-90 were previously presented. Claims 8-37 and 50 are canceled. Claims 38-48 and 55-65 are withdrawn. Accordingly, claims 1-7, 49, 51-54, and 66-90 are pending examination.

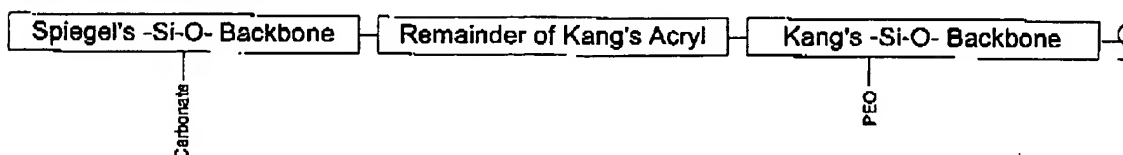
Rejection of Independent Claims 1 and 49

Independent claims 1 and 49 stand rejected as being unpatentable over U.S. Patent number 6,783,897 (Spiegel) in view of U.S. Patent number 6,783,897 (Kang).

The cited art does not teach or suggest every element of the claims.

Independent claims 1 and 49 are each amended to recite that “the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane.”

The rejection of independent claims 1 and 49 (and the remainder of the claims as well) appears based on using the crosslinking agent of Kang to crosslink the polysiloxane of Spiegel. This cross-linking would be achieved by reacting acryl functional groups on Kang's crosslinking agent (Kang at C4, L43-46, etc.) with Spiegel's polysiloxane. As a result, in the final product, the portion of these acryl groups that remains after the crosslinking reaction would be located between Kang's polysiloxane backbone and Spiegel's polysiloxane backbone. The Applicant believes the relevant portions of this arrangement could be illustrated as follows:



Suppose that this arrangement can be achieved and the backbone of Spiegel's polysiloxane serves as the first backbone recited in the claims. In this arrangement, the reacted portion of Kang's crosslinking agent would have to serve as the recited first sidechain. However, as is evident from the above diagram, Kang's crosslinking agent does not terminate before linking Spiegel's polysiloxane backbone to Kang's polysiloxane

backbone. As a result, this arrangement does not teach or suggest "the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane."

Now suppose that this same arrangement can be achieved but the backbone of Kang's polysiloxane serves as the first backbone recited in the claims. In this arrangement, the recited second sidechain would have to include both Spiegel's polysiloxane and the portion of Kang's acryl groups that remains after the crosslinking reaction. However, as is evident from the above diagram, this sidechain would not terminate before linking Kang's polysiloxane backbone to Spiegel's polysiloxane backbone. As a result, this arrangement also does not teach or suggest "the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane."

Since the modification upon which the pending rejection relies does not teach or suggest every element of claim 1, claim 1 is patentable over the cited art.

Lersch Is Non-Analogous Prior Art.

In order "to rely on a reference under 35 USC §103, it must be analogous prior art." See header of MPEP §2141.01(a). Applicant submits that Lersch is non-analogous art.

MPEP §2141.01(a) provides a two-part test for determining whether a piece of prior art is analogous prior art. First, "the reference must ... be in the field of the applicant's endeavor." MPEP §2141.01(a) also cites *Wang Laboratories, Inc. vs. Toshiba Corporation*, 993 F.2d 858, 26 U.S.P.Q. 2d 1767 (Fed. Cir., 1993). Applicant's field of endeavor is batteries (see Background) while Lersch's field of endeavor could be characterized as additives for dispersion paints or lacquers (see Abstract and C5, L51-52); or could be characterized as coatings for the surfaces of pigments and fillers (see Abstract and C5, L51-52); or as polymer synthesis (see Abstract and Title). In any of these cases, Lersch's field of endeavor could NOT be characterized as batteries. As a result, Lersch fails the first part of the test.

MPEP §2141.01(a) sets forth the second part of the two-part inquiry when it states that if the reference is not in Applicant's field of endeavor, it must "be reasonably pertinent to the particular problem with which the inventor was concerned." Further, a "reference is reasonably pertinent if ... it ... logically would have commended itself to an inventor's

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attention in considering his problem." See MPEP §2141.01(a) citing to *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

The "particular problem" addressed by Applicant's claimed invention is easily identified from the Background of the specification. The last two sentences of the Background state the following:

... polysiloxane based electrolytes typically have a low ionic conductivity that limits their use to applications that do not require high rate performance. As a result, there is a need for polysiloxane-based electrolytes with an increased ionic conductivity.

As a result, the inventors are addressing the problem of low ionic conductivity in polysiloxane-based electrolytes. However, since Lersch does not even teach using the disclosed polysiloxanes in the electrolyte of an electrochemical device, Lersch does not suggest that Lersch's polysiloxanes would increase the ionic conductivity of such an electrolyte. As a result, the inventors would not have consulted Lersch in order to solve their problem.

Because Lersch is both from a different field of endeavor and is not reasonably pertinent to the Applicant's problem, Lersch fails both parts of the MPEP §2141.01(a) analogous art test. Because Lersch is not analogous prior art, Lersch is not available for use in a rejection of these claims under 35 USC §103 and the rejections should be withdrawn.

Claims 2-7, 51-54, and 66-90

Claims 2-7, 51-54, and 66-90 each depends directly or indirectly from independent claim 1 or 49. Since claims 1 and 49 are each believed to be in condition for allowance, claim 2-7, 50-54, and 66-90 are also believed to be in condition for allowance.

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CONCLUSION

The Examiner is respectfully requested to telephone Travis Dodd at (760) 415-2352 with any questions.



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